



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,165	05/23/2000	Kia Silverbrook	NPA009US	9187

24011 7590 08/04/2006

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER

LIPMAN, JACOB

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,165

Applicant(s)

SILVERBROOK ET AL.

Examiner

Jacob Lipman

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 25-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "reference points" has not been defined in the specification. The specification never discloses including a plurality of reference points on/of the document.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 37 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 37, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 42 recites the limitation "the ticket or coupon". There is insufficient antecedent basis for this limitation in the claim. Even ignoring the "such as" rejection of claim 37, claim 35 does not disclose a ticket or coupon.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 25-28, 34-36, 38, 39, 42-44, and 48-50, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Izawa et al., US Patent number 5,420,406.

With regard to claims 25, 35 and 43, Izawa discloses a method for verifying secure documentation (column 1 lines 7-10) by providing a secure document having user discernable and coded data (column 2 lines 32-34), the coded data indicative of document identifier (column 2 lines 56-64) and reference points on the document (column 2 lines 56-59), recording in a computer (column 5 lines 3-7) a correspondence between the document and validity status (column 5 lines 21-32), receiving data from a sensing device adapted to sense the coded data (column 5 line 6) and position of the coded data (column 3 lines 22-34) and verifying the validity status using the correspondence recorded in the computer system (column 5 lines 29-32).

With regard to claims 26 and 38, Izawa discloses the coded pattern can be printed on both sides of the document (column 3 lines 9-13) and is viewed through the document (column 2 lines 42-46).

With regard to claims 27, 39, and 49, Izawa discloses the coded data can be substantially invisible (column 7 lines 15-18).

With regard to claims 28, 44, 48, and 50, Izawa discloses that the document has been printed (column 2 lines 56-59).

With regard to claims 34 and 36, Izawa discloses the sensing device controls the motor (column 6 lines 35-42) thus any data received by the motor identifies the sensing device, and the result can be queried by seeing if the motor runs in reverse or forward.

With regard to claim 42, Izawa discloses the validity status indicates whether the coupon has been canceled (column 7 lines 27-32).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29, 30-33, 37, 40, 41, 45-47, and 51-54, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al., US Patent number 5,710,419, in view of Izawa.

With regard to claims 29 and 40, Izawa discloses the method for providing a secure document as outlined above, but does not mention a photograph on the ticket. Wang discloses a similar method for providing a secure document, such as a ticket (column 6 line 21-22) including a photograph (column 6 lines 23-26). It would have been obvious to one of ordinary skill in the art to add a photograph to Izawa's secure document, to increase security.

With regard to claims 30-33, 37, 41, 45-47, and 51-54, Izawa discloses the method for providing a secure document as outlined above and Izawa discloses the secure document can be a ticket or coupon (column 7 lines 5-8), but does not mention buying the ticket with e-commerce. The examiner takes official notice that purchasing tickets over the Internet is well known in the art. It would have been obvious to one of ordinary skill in the art to apply Izawa's security method to tickets sold over the Internet, so as to improve their security.

Double Patenting

9. Applicant is advised that should claim 25 be found allowable, claim 35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

10. Applicant's arguments filed 30 May 2006 have been fully considered but they are not persuasive.

With regard to applicant's argument that reference points is not new matter, the examiner points out that reference points were not disclosed in the original specification. Applicant argues, "It is also clear that a reference is so small that it resembles a point". Applicant gives no support for this statement. Applicant states that reference points are broader than tags, but does not give support for the broader limitation in the specification. If there is support in the specification for a reference broader than tag, applicant is urged to point it out.

With regard to applicant's argument that the term "substantially" would be understood by one of ordinary skill in the art, the examiner is persuaded.

With regard to applicant's argument that Izawa does not disclose the sensing device generate position data, the examiner points out that pulse counter is a sensor sensing the location of the bill. Further, a bar code inherently has reference points which location is sensed when decoding, in that the location and width of each line is used for decoding.

With regard to applicant's argument that claims 25 and 35 have a difference in scope, the examiner points out that each is inherent in view of the other. Applicant argues that the recording in claim 35 can be done in the past by a third party. The examiner points out that there is not time frame claimed in either claim, nor is there a third party claimed. If a correspondence has been recorded in a computer system, than

Art Unit: 2134

at one time it was recorded in the computer system, thus recording is inherent in claim 35.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Th 7 AM-3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571-272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

A handwritten signature in black ink, appearing to read "Jacob Lipman", is written over the printed name.